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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/906,365	08/05/1997	RAMESH A. BHAT	0646/0D205	6767
32801	7590	12/28/2005	EXAMINER	
DARBY & DARBY P.C. P.O. BOX 5257 NEW YORK, NY 10150-5257			BASI, NIRMAL SINGH	
			ART UNIT	PAPER NUMBER
			1646	
DATE MAILED: 12/28/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/906,365

Applicant(s)

BHAT ET AL.

Examiner

Nirmal S. Basi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 27-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 27, 28 and 30-35 is/are allowed.
- 6) ☒ Claim(s) 29, 36-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. The suspension of this application is withdrawn. The claims are newly rejected due a US patent that has issued and is considered prior art.
2. Amendment filed 7/2/02 has been entered. Claims 27-49 are pending in the Application and will be examined.
3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 36-44 are rejected under 35 U.S.C. 102(e) as being anticipated by Mosselman et al (US Patent 6,680,368, issued 1/20/04, priority date 3/26/97).

Mosselman discloses an isolated nucleic acid (SEQ ID NO:24) encoding an estrogen receptor- β (SEQ ID NO: 25). The isolated estrogen receptor- β (SEQ ID NO: 25) disclosed by Mosselman has 100% query match and 100% best local similarity to the estrogen receptor- β of SEQ ID NO: 2 of instant invention. The isolated nucleic acid,

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SEQ ID NO: 24, disclosed by Mosselman has 98.9% query match and 99.9% best local similarity to the claimed nucleic acid encoding the estrogen receptor- β of SEQ ID NO:1 of instant invention. The sequence comparisons are attached. It is clear from SEQ ID NO:24 that the first in-frame upstream initiation translation codon is present at position 77-79 in SEQ ID NO:24. The coding sequence for estrogen receptor- β (SEQ ID NO: 25) contained in the polynucleotide of SEQ ID NO:24 is identical to the coding sequence for estrogen receptor- β (SEQ ID NO: 2) contained in the polynucleotide of SEQ ID NO:1 of instant invention. Therefore expression of the Mosselman polynucleotide of SEQ ID NO:24 would inherently produce the polypeptide of SEQ ID NO:2 of instant invention.

The patent of Mosselman discloses all the limitation contained in claims 36-44.

Mosselman teaches:

- a) An isolated nucleic acid having a sequence encoding an amino acid sequence depicted in Figure 4, SEQ ID NO:2, which is flanked by a heterologous sequence (see, columns column 7, Examples and SEQ ID NO:24, for example)
- b) The nucleic acid of claim 36, wherein said nucleic acid is DNA sequence (see, columns column 7, Examples and SEQ ID NO:24, for example)
- c) The RNA transcript of the nucleic acid of claim 36 (Fig 1, column 12, last paragraph).
- d) A recombinant DNA vector comprising the nucleic acid of claim 36 (see, columns column 6, 7 and 13)
- e) A recombinant DNA vector comprising the nucleic acid of claim 36 operably linked to a transcription regulatory element (see, columns column 6, 7 and 13)

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f) A cell comprising a DNA vector of claim 40 (see, columns column 6, 7,13 and 14)

g) The cell of claim 41, which is selected from the group consisting of bacterial, fungal, plant, insect, and mammalian cells (see, columns column 6, 7,13 and 14). More specifically see column 6, line 7-16.

.h) A method for producing a polypeptide, which method comprises incubating the cell of claim 41

under conditions that permit expression a polypeptide encoded by the nucleic acid column 6, 7 and 12-14).

l) The method of claim 43, which further comprises harvesting said incubated cells and recovering the polypeptide (column 7).

The limitations of claims 36-44 are met by the disclosure of Mosselman, absent evidence to the contrary.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 29, 38 and 43 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 29 is indefinite because the nucleic acid of claim 27 cannot be a RNA.

The nucleic acid disclosed in SEQ ID NO:1 is DNA. The limitation of claim 29 is that the nucleic acid of claim 27 be RNA. The base structure of DNA and RNA is different.

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Claims 38 is indefinite because the nucleic acid of claim 36 cannot be a RNA.

The nucleic acid encoded the polypeptide disclosed in SEQ ID NO:2 is DNA. The limitation of claim 29 is that the nucleic acid of claim 27 be RNA. The base structure of DNA and RNA is different.

Claim 43 is not grammatically correct and therefore does not make sense due to the omission of the word "of" following the letter "a" on line of the claim. It is suggested to overcome the rejection the claim be amended with the addition of "of" as indicted or the other appropriate language.

Allowable Subject Matter

6. Claims 27-28, 30-35 are allowable over the prior art.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nirmal S. Basi whose telephone number is 571-272-0868. The examiner can normally be reached on 9:00 AM-5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony C. Caputa can be reached on 571-272-0829. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nirmal S. Basi
Art Unit 1646
December 9, 2005


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SUPERVISORY PATENT EXAMINER
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